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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/685,204	10/10/2000	Vladimir B. Brik		4322

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[REDACTED] EXAMINER

HOFFMANN, JOHN M

ART UNIT	PAPER NUMBER
1731	11

DATE MAILED: 11/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/685,204	BRIK, VLADIMIR B.
Examiner	Art Unit	
John Hoffmann	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 16 October 2002 .

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-40 is/are pending in the application.

4a) Of the above claim(s) 9,10,13,14,16-27,29-32 and 38-40 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-8, 11-12, 15, 28,33-37 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election of Invention I in Paper No. 10 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 9-10, 13-14, 16-27, 29-32 and 38-40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 11.

In other words, claims 1-8, 11-12, 28 and 33-37 are the claims which are being examined. All other claims will be ignored for the time being.

Priority

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date as follows: The second application must be an application for a patent for an invention which is also disclosed in the first application (the parent or provisional application); the disclosure of the invention in the parent application and in the second application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ 2d 1077 (Fed. Cir. 1994).

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This application repeats a substantial portion of prior Application No. 09/268634 and adds and claims additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it may constitute a continuation-in-part of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

To summarize: on the first page of the application, it is stated that the application is a "continuation" of Application 09/268,634. This is not accurate because the disclosures are not identical, and thus this present application (09/685,204) is not a continuation of 09/268,634. However, it is OK to change the first page to indicate that the present application (09/685,204) is a "continuation-in-part" of 09/268,634.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

First, The wrong form was used. The Declaration that Applicant submitted is titled: Plant Patent Application. The invention has nothing to do with plants (e.g. flowers and trees). Applicant needs to use a declaration for "Utility Patents"

Also, page 1 of the Declaration is missing.

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Also, the form is filled out incorrectly. The sheet with the title: Supplememntal Priority Data Sheet refers to various patents that do not belong to Applicant. Therefore it is improper for Applicant to claim **priority** to those patents. For example patent 5998021 was given to a man named "Loftus" - not "Brik". Only those applications that were actually invented by you can be listed on the "Priority Data Sheet". And if any those patents were invented by Applicant, the application number must be listed NOT the patent number.

Furthermore, the following apply:

The oath or declaration is defective because:

It does not state that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

The specification to which the oath or declaration is directed has not been adequately identified. See MPEP § 601.01(a).

It does not state that the person making the oath or declaration has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration.

Response to Amendment

In the response that Applicant sent that was dated 17 Spetember 2002, it appears that applicant might have intended to amend the claims. Nothing was done with the papers because there was no clear directions to amend the claims, such as: "Please amend the claims to read as follows:" Furthermore, there was no clean copy of the claims.

Here are the requirements for claims:

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37 CFR 1.121(c) states:

(c) Claims.

(1) Amendment by rewriting, directions to cancel or add: Amendments to a claim must be made by rewriting such claim with all changes (e.g., additions, deletions, modifications) included. The rewriting of a claim (with the same number) will be construed as directing the cancellation of the previous version of that claim. A claim may also be canceled by an instruction.

(i) A rewritten or newly added claim must be in clean form, that is, without markings to indicate the changes that have been made. A parenthetical expression should follow the claim number indicating the status of the claim as amended or newly added (e.g., "amended," "twice amended," or "new").

(ii) If a claim is amended by rewriting such claim with the same number, the amendment must be accompanied by another version of the rewritten claim, on one or more pages separate from the amendment, marked up to show all the changes relative to the previous

version of that claim. A parenthetical expression should follow the claim number indicating

the status of the claim, e.g., "amended," "twice amended," etc. The parenthetical expression "amended," "twice amended," etc. should be the same for both the clean version of the claim under paragraph (c)(1)(i) of this section and the marked up version under this paragraph. The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system. A marked up version does not have to be supplied for an added claim or a canceled claim as it is sufficient to state that a particular claim has been added, or canceled.

(2) A claim canceled by amendment (deleted in its entirety) may be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

IN summary, for an amendment there must be: (1) clear direction as what is to be done, (2) a copy of the claims in clean form, (3) a marked-up copy of the claims.

Claims 1-8, 11-12, 28 and 33-37 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a

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manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

Here are some of the problems with claim 1:

It starts out with claim an "apparatus and method". This is improper - it has to be one or the other. The phrase "such as" at line 2 is unclear whether it must actually be able to make fibers out of basalts. The term "drawn / attenuated": it is unclear if it is to mean "drawn or attenuated" or "drawn and attenuated". It refers to "said elemental fibers" (line 3) but there is no prior saying of "elemental fibers" thus it is improper to use the term "said". It is not understood what is meant by a fiber being "elemental". It is unclear if "flexible/ductile" line 5 means "flexible and ductile" or "flexible or ductile". Line 5 has a period - meaning that one sentence ends: this is not permitted because a claim must be exactly one sentences long. Part (d) refers to "In special embodiments" - it is unclear whether the claim is limited to the special embodiments or not.

Claim 4 refers to "said sloped valley" - but claim 1 refers to two such valleys. Thus it is unclear if claim 4 describes just one of the valleys or to both of the valleys.

The claims are full of many grammatical errors

These are just a few of the many, many problems in the claims. This list is not intended to be exhaustive. If Applicant wishes to pursue the present claims, the burden is completely on Applicant to find all of the errors and to fix them.

Allowable Subject Matter

The following claim, drafted by the examiner and considered to distinguish patentably over the art of record in this application, is presented to applicant for consideration:

An apparatus for forming mineral fibers of a size between 7 and 100 microns, wherein the apparatus comprises:

(a) a vertically oriented furnace having a first side, and a second side opposite the first side;

(b) ~~a~~ first and second melting chambers, wherein the chambers are at the top of the furnace and wherein the first chamber is positioned at the first side and the second chamber is positioned at the second side;

(c) a first adjustable sloped valley member under the first melting chamber, and a second adjustable sloped valley member under the second melting chamber;

(d) a vertical stack of horizontal valley members, wherein each horizontal valley member has an open ^{top} _{end} to permit molten material to cascade down the stack;

(e) a glass collector member for receiving the molten material from the stack;

(f) two forehearts for receiving the molten material from the collector member;

(g) a raised throat which retains higher- density glass component ^S _{in} the collector member and permits the passage of lower-density glass components; and

(k) two-chamber ceramic bushings in each of the forehearts, wherein each bushing comprises at least two ceramic plates with orifices;

wherein the valley members have various heights to promote mixing and degassing

and wherein each bushing further comprises water-cooled fins comprising TiNi intermetallic walls, wherein the TiNi is water vapor permeable.

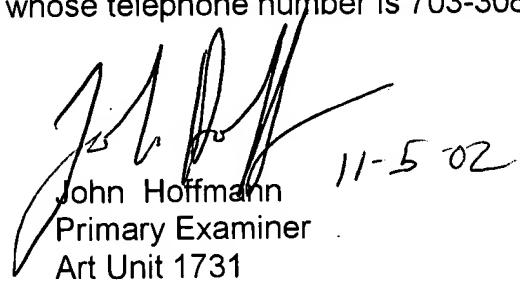
In other words, if Applicant submits an amendment presenting this new claim (and canceling all of the other claims, and submitting a proper declaration) then the application will be allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is 703-308-0469. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 703-308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7115 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



11-5 '02

John Hoffmann
Primary Examiner
Art Unit 1731

jmh

November 5, 2002